

REMARKS

Reconsideration of the application in light of the following remarks is respectfully requested.

Status of the Claims

Claims 1-13 are pending in the application.

Claim 3 has been objected to for failing to particularly point out and distinctly claim the subject matter of the claimed invention. Specifically, the Examiner contends that the recital of “... intentionally provided by said certain recipient” renders the claim indefinite by “appear[ing] to require an inquiry into a recipient’s state of mind to determine intent.” (Detailed Action, page 2 bridging page 3. (Emphasis in original.))

Applicant respectfully submits that an inquiry into a recipient’s state of mind is not required by the claimed invention. Claim 3 is directed to distributing information or services through a computer or cellular network, and recites the step of “identifying an account the identifier of which has been intentionally provided by said certain recipient.” The claims requires that the method identify an account where the recipient has taken some affirmative action to provide the account identifier; the claim does not require a determination as to the recipient’s state of mind.

Additionally, the claim language that the Examiner now objects to is language that appeared in original claim 3, and has not been added by amendment. Because the Examiner is now making a new objection that could have been made in a prior Office Action, Applicant submits that this Office Action should not have been deemed final. Therefore, Applicant requests that the finality of this Office Action be withdrawn so that the above argument is entered into the case, and so that the Applicant can have an opportunity to respond to any further objection/rejection that the Examiner might make.

Reconsideration of the objection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 112

Claims 1, 8, 9, 11, and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner contends that the disclosure of the “. . . preliminary order for crediting the accounts . . . ,” does not provide details. The Examiner states that “[f]or examination purposes, the Examiner will interpret the phrase . . . [to mean] a maximum amount or a fixed amount that a provider is willing to compensate those customers that access the information.” (Detailed Action, page 3.) Applicant respectfully traverses the rejection.

Applicant respectfully disagrees with the Examiner’s position. The specification clearly explains that “[t]he preliminary nature of the order means that the actual crediting is not yet accomplished, because there is no evidence about the intended recipients actually receiving the information or service to be transmitted.” (Specification, page 7, lines 30-34.) Once there is evidence that the intended recipients have actually received the information or service to be transmitted, than the crediting will occur. Further, the Specification discloses other embodiments of the present invention and discusses the preliminary order, e.g., page 9, lines 20-35.

Thus, the basis for the Examiner’s interpretation of the phrase is not understood is inaccurate, and does not comport with the unequivocal definition provided by the cited portion of the specification. Reconsideration and withdrawal of this rejection is requested.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-6 and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goldhaber et al. (U.S. Patent No. 5,794,210) (“Goldhaber”). Applicant respectfully traverses the rejection.

Applicant submits that Goldhaber is directed to a system which provides for the **immediate payment** to users for paying attention to an advertisement distributed over a computer network. Orthogonal Sponsorship, allows advertisers to detach their messages from program content and

explicitly target their audience. A special icon displayed on a computer screen may represent compensation and allow users to choose whether they will view an ad and receive associated compensation. Targeting users may be provided by reference to a data base of digitally stored demographic profiles of potential users. Information can be routed to users based on demographics. Goldhaber does not teach, nor suggest, transmitting a preliminary order for crediting accounts associated with the intended recipients, as required by the claimed invention.

The Examiner relies on Goldhaber, Fig. 2 and the related text as disclosing “transmitting through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients.” (Detailed Action, page 4.) Applicant submits that Fig. 2 and the related text, (*see* col. 10, lines 8-38), discloses that a consumer requests information, the consumer is asked to compensate the provider for the information, the consumer pays for the information, and the provider provides the information. This section of Goldhaber has nothing to do with transmitting a preliminary order for crediting accounts, as required by the claimed invention.

Moreover, this portion of Goldhaber does not teach the “preliminary” feature as inaccurately interpreted by the Examiner. As discussed above, the Examiner wrongly interprets this feature as “a maximum amount or a fixed amount that a provider is willing to compensate those customers that access the information.” In Goldhaber the consumer is compensating the provider of information; the provider is not compensating the customer.

Further, the Examiner contends that the Applicant has relied on features not present in the claims. (*See*, Detailed Action, page 9.) However, in the previous Response, Applicant merely asserted that one of the advantages of the “preliminary” feature is that by transmitting a preliminary crediting order before transmitting the information or service to the subscriber terminals, there is a reduction in the service provider's chance for cheating. This assertion of advantage should not distract the Examiner from the fact that the “preliminary” feature recited in the claims is distinguishable over the Goldhaber reference itself.

Withdrawal and reconsideration of the rejection is requested.

Claim Rejection Under 35 U.S.C. § 103

Claims 7 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber in view of the Examiner's statement of what was known in the art at the time of the invention. Applicant respectfully traverses the rejection.

With respect to the rejection of claim 7, the Examiner acknowledges that Goldhaber fails to disclose "that crediting an account associated with said certain recipient comprises the substeps of defining the time it has taken for said indication to be received and crediting said account by an amount which is inversely proportional to said time." (Detailed Action, page 7.) The Examiner contends that Goldhaber discloses the use of time-sensitive incentives such as coupons and relies on the Examiner's own personal knowledge that it would have been obvious "to extend Goldhaber to disclose time-sensitive credits, **perhaps** based on a subscriber's response time." (Emphasis added.)

First, the Examiner's statement of what was known in the art at the time of the invention is not supported by any "concrete evidence in the record . . ." (See MPEP § 2144.04(c), citing *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).) Accordingly, Applicant submits that the Examiner is relying on personal knowledge and respectfully requests that the Examiner supports this personal knowledge with affidavits containing data as specific as possible pursuant to 37 C.F.R. §1.104(d)(2). In accordance with § 1.104(d)(2), Applicant is permitted to contradict or explain such affidavits with affidavits of the Applicant or other persons. Applicant submits that without supporting evidence, the Examiner has impermissibly relied on personal knowledge and, thus, has not established a *prima facie* case of obviousness. As a procedural matter, Applicant respectfully submits that the Examiner has improperly deemed the present Office Action as a Final Office Action.

Applicant submits that Goldhaber's disclosure of coupons does not make obvious the claimed feature of crediting the account by an amount which is inversely proportional to the time. First, Goldhaber neither discloses, nor suggests, that its coupons are time-sensitive. And even assuming that Goldhaber were to suggest that the coupons were time-sensitive, it would not have

been obvious to one of ordinary skill to arrive at crediting the account by an amount which is inversely proportional to the time. Applicant submits that the Examiner has impermissibly relied on the disclosure of the present application “to reconstruct the patentee’s claimed invention from prior art by using the patentee’s claim as a ‘blueprint’ when prior art references require selective combination to render obvious a subsequent invention.” (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, *citing Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

Further, the Examiner contends that “[i]f applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art.” The Examiner then goes on to assert that the following is admitted prior art:

... the value of information is often greatest when the information is first posted. ... information would likely be of less value as more time passes. Therefore an advertiser may pay less and less as time passes.

Applicant respectfully disagrees with the Examiner. First, the Examiner did not properly take official notice of common knowledge. MPEP § 2144.03 makes it clear that “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well known . . . are capable of instant and unquestionable demonstration as being well known.” In rejecting claim 7 the Examiner used vague language such as “the value of information is often greatest when the information is first posted,” and “information would likely be of less value as more time passes, and also “an advertiser may pay less and less as time passes.” (Emphasis added.) Such a statement with its vague language (i.e., often, likely, may) could hardly be interpreted as asserting facts “capable of instant and unquestionable demonstration as being well known.”

Moreover, Applicant traversed the Examiner’s rejection by asserting that it would not have been obvious to credit an account by an amount which is inversely proportional to the time.

Therefore, in the previous amendment, Applicant did object to that Examiner's statements. Applicant has not admitted that anything is prior art, and maintains that claim 7 is patentable.

Additionally, in formulating the present rejection of claim 7 the Examiner has again used vague language, (i.e., "to extend Goldhaber to disclose time-sensitive credits, **perhaps** based on a subscriber's response time"). Such a statement with its vague language (i.e., "perhaps") could hardly be interpreted as asserting facts "capable of instant and unquestionable demonstration as being well known."

With respect to the rejection of claim 13, the Examiner acknowledges that "Goldhaber **does not** specifically disclose crediting an account by (a) ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and (b) crediting said account associated with said certain recipient based on the order ranking." (Detailed Action, page 8. (Emphasis in original.))

The Examiner admits that Goldhaber does not teach these features. In an attempt to make up for Goldhaber's deficiencies, the Examiner argues that it is well known to reward early responders, and this is admitted prior art. Based on this position, the Examiner argues that the features of claim 13 would have been obvious.

As discussed above, Applicant again submits that there has been no admission that anything is prior art. Moreover, even if it were known to reward early responders, it still would have not been obvious to rank the order of responses of recipients, and crediting accounts based on the ranking. Being known to reward early responders would result in rewarding responders based on an amount of time which has passed, not on a ranking. There could be large gaps of time between responses. Thus, claim 13 is patentable over Goldhaber for at least this reason.

Reconsideration and withdrawal of the rejection is requested.

CONCLUSION

Each and every point raised in the Final Office Action mailed December 15, 2005 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-13 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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